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Defendant SANDISK CORPORATION*

**UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA
SAN FRANCISCO DIVISION**

SANDISK CORPORATION,

Plaintiff and
Counterclaim
Defendant,

v.

ROUND ROCK RESEARCH LLC,

Defendant and
Counterclaim Plaintiff.

Case No. 3:11-cv-05243-RS

**STIPULATION AND ~~PROPOSED~~
ORDER DISMISSING CERTAIN
CLAIMS AND ENTERING FINAL
JUDGMENT**

By Orders dated June 13, 2014, the Court granted SanDisk's motion for summary judgment of exhaustion on all of Round Rock's infringement claims relating to U.S. Patent Nos. 6,570,791 and 6,845,053 (Dkt. No. 358), and granted SanDisk's motion to strike its SD, microSD, and iNand

1 products from this case with respect to U.S. Patent No. 5,682,345 (Dkt. No. 360), among other
2 things. In light of the Court's Orders, the only infringement allegations remaining in this case are:
3 (i) the alleged infringement of U.S. Patent No. 6,383,839 in connection with SanDisk's microSD
4 Memory Cards; and (ii) the alleged infringement of U.S. Patent No. 5,682,345 in connection with
5 SanDisk's mDOC products.

6 In view of the limited potential recovery relating to the remaining infringement claims
7 compared to the expense of proceeding with trial on these claims, Round Rock hereby covenants not
8 to assert infringement claims against SanDisk or its customers for infringement of U.S. Patent No.
9 6,383,839 ("the '839 patent") based upon the past or future manufacture, use, sale, offer for sale, or
10 importation of the SanDisk products currently at issue in this action with respect to the '839 patent,
11 *i.e.*, the accused SanDisk microSD Memory Cards. Round Rock further covenants not to assert
12 infringement claims against SanDisk or its customers for infringement of U.S. Patent No. 5,682,345
13 ("the '345 patent") based upon the past or future manufacture, use, sale, offer for sale, or importation
14 of the SanDisk products currently at issue in this action with respect to the '345 patent, *i.e.*, the
15 accused SanDisk mDOC products. The remaining claims in this action that were not resolved by the
16 Court on summary judgment are therefore moot.

17 Accordingly, pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(ii), SanDisk
18 Corporation ("SanDisk") and Round Rock Research LLP ("Round Rock") hereby stipulate to
19 dismiss the following causes of action in connection with the remaining pending claims in this
20 action. SanDisk stipulates to dismiss its second cause of action (Declaratory Judgment of Invalidity
21 of U.S. Patent No. 6,383,839) and its fourth cause of action (Declaratory Judgment of Non-
22 Infringement of U.S. Patent No. 5,682,345) without prejudice, and Round Rock stipulates to dismiss
23 the second count of its counterclaims (Infringement of U.S. Patent No. 5,682,345) and the seventh
24 count of its counterclaims (Infringement of U.S. Patent No. 6,383,839) with prejudice.

25 No further issues remain for trial. The parties therefore respectfully request that the Court
26 enter final judgment pursuant to its June 13, 2014, Order (Dkt. No. 358) in favor of SanDisk on its
27 sixth cause of action (Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,570,791) and
28 twelfth cause of action (Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,845,053),

1 and against Round Rock on Count VIII of its counterclaims (Infringement of U.S. Patent No.
 2 6,570,791) and Count XII of its counterclaims (Infringement of U.S. Patent No. 6,845,053). Each
 3 party shall bear its own costs and attorneys' fees.

4
 5 Dated: July 3, 2014

Respectfully submitted,

6 By: /s/ Bradford J. Black
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20 Attorneys for Defendant and Counterclaim
 Plaintiff ROUND ROCK RESEARCH LLC

Attorneys for Plaintiff and Counterclaim
 Defendant SANDISK CORPORATION

21
 22 **Civil L.R. 5-1(i)**

23 I, Bradford J. Black, hereby attest that Leo L. Lam has concurred in the filing of this
 24 document.

25 By: /s/ Bradford J. Black
 26 Bradford J. Black

CERTIFICATE OF SERVICE

The undersigned certifies that on July 3, 2014, the foregoing document was filed with the Clerk of the U. S. District Court for the Northern District of California, using the court's electronic case filing system (ECF), in compliance with Civil L.R. 5-1. The ECF sends a Notice of Electronic Filing (NEF) to all parties and counsel who have appeared in this action and who have consented under Civil L.R. 5-1 to accept that NEF as service of this document.

/s/ Bradford J. Black

Bradford J. Black


~~PROPOSED~~ ORDER

Pursuant to the above stipulation, the following causes of action in connection with the remaining pending claims in this action are hereby dismissed. SanDisk's second cause of action (Declaratory Judgment of Invalidity of U.S. Patent No. 6,383,839) and its fourth cause of action (Declaratory Judgment of Non-Infringement of U.S. Patent No. 5,682,345) are hereby dismissed *without prejudice*, and Round Rock's second count of its counterclaims (Infringement of U.S. Patent No. 5,682,345) and seventh count of its counterclaims (Infringement of U.S. Patent No. 6,383,839) are hereby dismissed *with prejudice*.

Further, for the reasons set forth in the Court's June 13, 2014, Order (Dkt. No. 358), the Clerk is directed to enter judgment pursuant to Fed. R. Civ. P. 58 in favor of SanDisk Corporation on its sixth cause of action (Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,570,791) and twelfth cause of action (Declaratory Judgment of Non-Infringement of U.S. Patent No. 6,845,053), and against Round Rock on Count VIII of its counterclaims (Infringement of U.S. Patent No. 6,570,791) and Count XII of its counterclaims (Infringement of U.S. Patent No. 6,845,053). This Order resolves all remaining issues between the parties, and each party shall bear its own costs and attorneys' fees.

IT IS SO ORDERED.

Dated: 7/3/14



Honorable Richard Seeborg
United States District Judge